

(b) REMARKS

In the outstanding Advisory Action the Examiner argued that there is no objective evidence in the present record to show that the definitions of weights of liberation in Magome US 2001/028988 (Magome) are the standard and acceptable definitions in the art. To resolve that issue, Applicants have enclosed a Rule 132 Declaration by the present inventors who are highly experienced in this field. In paragraphs 9 and 10 of the enclosed Declaration, it is noted that a weight of liberation of a certain substance from the toner particle is a well-known concept as indicated in paragraph [0108] in Magome. In addition, in Declaration paragraph No. 13, the declarants have discussed how the rate of liberation can be obtained by the artisan based on the state of the art as evidenced in U.S. Patent No. 6,146,802 ('802 patent), including the description of Figs. 1-3 in columns 17-19 of that patent. Applicants have attached a copy of the appropriate disclosure in the '802 patent, as well as Figs. 1-3, for the Examiner's convenience.

The Declaration now provides how the liberation states are measured as further evidenced by Magome and the '802 patent. An information submission has been enclosed which formally makes the '802 patent of record.

Accordingly, it is requested that this paper and the enclosed Rule 132 Declaration be entered and considered by the Examiner, together with the previous Rule 1.114 submission filed with the RCE.

An early and favorable action on the merits is requested.

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Peter Saxon", written over a horizontal line.

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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
: Examiner: Janis L. Dote
KATSUHISA YAMAZAKI ET AL.)
: Art Unit: 1756
Application No.: 10/660,638)
:
Filed: September 12, 2003)
:
For: DEVELOPER)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

DECLARATION UNDER TITLE 37 C.F.R. §1.132

We, KATSUHISA YAMAZAKI and TAKASHIGE KASUYA, declare that:

1. We both reside at Shizuoka, Japan.
2. I, KATSUHISA YAMAZAKI, have been a Research Scientist at Canon Kabushiki Kaisha since 1998. Prior to my employment at Canon I held the position of Research Scientist at TOYOBO., LTD. for a period of two years. I work in the area of electrophotographic development.
3. I, TAKASHIGE KASUYA, have been a Research Scientist at Canon Kabushiki Kaisha since 1987. I work in the area of electrophotographic development.
4. I, KATSUHISA YAMAZAKI, have received an undergraduate degree in Chemistry from Mie University in 1994 and a graduate degree in Engineering from Mie University in 1996.

5. I, TAKASHIGE KASUYA, have received an undergraduate degree in Industrial Chemistry from Tokyo University of Science in 1985 and a graduate degree in Engineering from Tokyo University of Science in 1987.

6. I, KATSUHISA YAMAZAKI, have had 8 patents issued in my name in the field of developers for electrophotography.

7. I, TAKASHIGE KASUYA, have had 35 patents issued in my name in the field of developers for electrophotography.

8. We are both inventors of the subject patent application and highly experienced in the field of developers for electrophotography and are familiar with the prosecution history of the subject patent application. In particular, we understand the Examiner in charge of the subject application has expressed concern regarding whether the rates of liberation recited in present claim 1 are well known and understood by those skilled in the art. We will address and resolve the Examiner's concerns as follows:

9. "A rate of liberation of a certain substance from the toner particle" means the percentage of the substance liberated from the toner particle. This is a well-known concept as indicated at paragraph [0108] in the Magome reference (US2001/0028988A1) among skilled persons in the art at the time when this application was filed.

10. The rate of liberation of the certain substance from the toner particle can be obtained from the expression as follows:

$$100 \times \left[\frac{\text{the amount of the certain substance being liberated from the toner particles}}{\text{the amount of the certain substance being attached to the toner particles} + \text{the amount of the certain substance being liberated from the toner particles}} \right]$$
. In other words, $100 \times \left[\frac{\text{the number of times of emission of the atom constituting the certain substance being liberated from the toner particles}}{\text{the number of times of emission of the atom constituting the certain}} \right]$

substance being attached to the toner particles + the number of times of emission of the atom constituting the certain substance being liberated from the toner particles)]”.

This is a well-known general matter as indicated at [0109] to [0111] in the 9/9
Magome reference among skilled persons in the art at the time when this application was filed.

11. The present specification discloses that the number of times of emission of the atom constituting the conductive fine particles is measured by using the indicated particle analyzer. The specification teaches that the attached state and the liberation state are distinguished by the emission of the atom constituting the conductive fine particles measured relative to the carbon atom emission. The attached state is characterized by emission within 2.6 msec of carbon emission. The liberation state is characterized by emission 2.6 msec after an emission of a carbon atom (page 25, line 5 to page 26, line 11 in the present specification). Thus, one of ordinary skill in the art can readily obtain the rate of liberation of the conductive fine particle on the basis of the description of the present specification by using the following expression.

“A rate of liberation of the conductive fine particle from the toner particle (%) =
$$100 \times \left[\frac{\text{(the number of times of emission of the atom constituting the conductive fine particle being measured thereafter 2.6 msec after an emission of a carbon atom)}}{\text{(the number of times of emission of the atom constituting the conductive fine particle being measured within 2.6 msec after an emission of a certain atom + the number of times of emission of the atom constituting the conductive fine particle being measured thereafter 2.6 msec after an emission of a carbon atom)}} \right]$$
.”

12. Similar to the case of the conductive fine particle, the rate of liberation of the inorganic fine particle can likewise be derived as above.

13. As discussed above, the rate of liberation of the conductive fine particle and the rate of liberation of the inorganic fine particle can be obtained by one of ordinary skill in the art from the description in the present specification on the basis of the well-known state of the art. Further, distinction and detection between the attached state and the liberation state are generally well-known matters among skilled persons in the art at the time when this application was filed, as evidenced by U.S. Patent No. 6,146,802. The description of Figs. 1-3 and column 17, line 45 to column 19, line 15 in this patent bear on this point.

14. We hereby declare that all statements made herein of our own knowledge are true and that all statements made on information and belief are believed to be true; and further that the statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under § 1001 of Title XVIII of United States Code, and that such willful false statements made jeopardize the validity of this application or any patent issued thereon.

Katsuhisa Yamazaki Date: February 9, 2006
KATSUHISA YAMAZAKI

Takashige Kasuya Date: February 9, 2006
TAKASHIGE KASUYA